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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,626	10/11/2001	Robert E. Haines	10007582-1	1665

7590

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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LIN, KELVIN Y

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,626

Applicant(s)

HAINES ET AL.

Examiner

Kelvin Lin

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **Detailed Action**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's argument about both the present application and Lomas are owned by Hewlett-Packard Company, accordingly, 35 USC 103(C) precludes reliance upon Lomas under 35 USC 103 is persuasive.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-35 are rejected under 35 U.S.C 103(a) as being unpatentable over Moshir et al., (US PG Pub No. 20020100036) in view of Okimoto et al., (US Pat. No. 6426799).
2. Regarding claim 1, Moshir teaches a method of configuring a hard copy output engine comprising:

- receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall (Moshir, [0021]-[0022], [0031], I.1-8, [0081], I.1-12, [0124], I.1-2, I.6-17, in which the printer connect to the computer and give a recipe, also the configuration including the hardware and software corresponds to the message including the output hardware configuration from any website through a firewall);

Although Moshir at the above mentioned prior art teaches the message including the hardware configuration data, Moshir fails to teach configuring the hard copy engine using the configuration data.

However, Okimoto teaches the

- configuring the hard copy output engine using the configuration data (Okimoto, fig.8, element S360 modify setting instruction, fig.9, showing a mail print selection process in the process in fig.8, col.21, I.34-48, discloses the setting for all attached file in the email. Moreover, col. 23, I.7-33, configuring for the color setting based on the information in the mail header).

Furthermore, Okimoto teaches a printer access procedure (configuration) for printers over a network via email (Okimoto, col.4, I.21-31).

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Moshir's hardware and software installation through network and has been guarded by

firewall with Okimoto's mail printing system to setup printer output format selection function.

The motivation would be for combining a network installation through network and firewall (Moshir, [0046], I.1-12) with Okimoto's email configuration structure and apply to the printer. Hence the print data will not be printed erroneously. The user on the receiving end can receive printed matter in the form desired by the user on the transmitting end (Okimoto, Abstract).

3. Regarding claim 2, Okimoto further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data (Okimoto, col.4, I.21-67, Fig. 1, two mail server, 24 and 26, in which the printer corresponds to the hard copy output engine receiving an email for output setting).
4. Regarding claim 3, Okimoto further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an email (Okimoto, col.1, I.40-50, col.4, I.31-37).
5. Regarding claim 3, Moshir further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an email.  
(Moshir, [0021], I. 3-4, I.11-15).
6. Regarding claim 4, Moshir further discloses the method of claim 1, wherein receiving the electronic message comprises:

- receiving an email through the firewall at a first user station (Moshir, [0052], I.3-5); and
  - forwarding the email to the hard copy output engine (Moshir, [0052], I.12-14).
7. Regarding claim 5, Moshir further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an XML script and configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (Moshir, [0086] I.8-12, inventories means many things like others such as, toner, marking material, hours of operation, and no. of sheets, and something used by statistics [like [0081], I.10, [0087], I.7.)
8. Regarding claim 6, Moshir further discloses the method of claim 1, wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (Moshir, [0049], I.1-3).
9. Regarding claim 7, Moshir further discloses the method of claim 1, wherein the configuration data include data prepared by: determining a make and model for the hard copy output engine; determining a serial number for the hard copy output engine; and determining user thresholds for consumables associated with the hard copy output engine (Moshir, [0024], I. 1-6).
10. Regarding claims 8-13 claiming for apparatus have similar limitations as claims 1-6. Therefore, Claims 8-13 are rejected for the same reasons set forth in the

rejection of claims 1-6.

11. Regarding claims 14-20 claiming for the system have similar limitations as claims 1-6. Therefore, Claims 14-20 are rejected for the same reasons set forth in the rejection of claims 1-6.
12. Regarding claims 21-26 claiming for computer usable medium have similar limitations as claims 1-6. Therefore, Claims 21-26 are rejected for the same reasons set forth in the rejection of claims 1-6.
13. Regarding claims 27-35 claiming for the firewall have similar limitations as claims 1-7. Therefore, Claims 27-35 are rejected for the same reasons set forth in the rejection of claims 1-7.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898. The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/28/06

KYL

  
**JASON CARDONE**  
SUPERVISORY PATENT EXAMINER